

1
2 Nathaniel L. Dilger (CA Bar No. 196203)
ndilger@onellp.com
3 Peter R. Afrasiabi (CA Bar No. 193336)
pafrasiabi@onellp.com
4 Taylor C. Foss (CA Bar No. 253486)
tfoss@onellp.com
5 **ONE LLP**
23 Corporate Plaza
6 Suite 150-105
Newport Beach, CA 92660
7 Telephone: (949) 502-2870
Facsimile: (949) 258-5081

8 William J. O'Brien (CA Bar No. 99526)
wobrien@onellp.com
9 **ONE LLP**
400 Corporate Pointe, Suite 300
10 Culver City, CA 90230
11 Telephone: (310) 866-5158
Facsimile: (949) 943-2085

12 *Attorneys for Plaintiff and Counter-Defendant,*
13 *FaceTec, Inc.*

14 **UNITED STATES DISTRICT COURT**
15 **NORTHERN DISTRICT OF CALIFORNIA**
16 **SAN FRANCISCO DIVISION**

17 FACETEC, INC., a Delaware corporation,
18
19 Plaintiff,
20 v.

21 JUMIO CORPORATION, a Delaware
corporation,

22 Defendant.

23 JUMIO CORPORATION, a Delaware
corporation,

24 Counterclaimant,

25 v.

26 FACETEC, INC., a Delaware corporation,

27 Counter-Defendant,
28

Case No. 3:24-cv-03623-RFL
Hon. Rita F. Lin

**REQUEST FOR VOLUNTARY
DISMISSAL WITHOUT PREJUDICE
UNDER FED. R. CIV. P. 41(a)(2)**

[Proposed] Order filed concurrently herewith

Complaint Filed: June 14, 2024

1 **I. Introduction**

2 Pursuant to Fed. R. Civ. P. 41(a)(2), Plaintiff FaceTec requests voluntary dismissal without
3 prejudice of its claims for patent infringement against Defendant Jumio.

4 Since the filing of FaceTec's complaint, FaceTec has received information that
5 significantly altered the calculus on which FaceTec based its decision to file this case. For almost
6 three years, FaceTec has been pursuing a patent infringement case against iProov Ltd. in the
7 District of Nevada (Case No. 2:21-cv-02252-ART-BNW), asserting two of the same patents
8 involved in this case. The products accused of infringement in that case include liveness detection
9 technology that iProov supplies to Jumio and that Jumio provides to many of its customers.
10 FaceTec, however, did not name Jumio as a defendant in that case.

11 An important factor in FaceTec's decision to file its present infringement case against
12 Jumio was Jumio's recent introduction of Jumio-branded liveness detection that was noticeably
13 different from the iProov products that had prompted the suit in Nevada. This seemingly different
14 Jumio technology was embodied in the "Jumio Showcase" apps available for Android and iOS.
15 On examining it, FaceTec learned that it infringed FaceTec's patents for the same reasons as
16 iProov's technology that prompted the Nevada suit and, indeed, was an even closer copy of
17 FaceTec in some ways than that iProov technology.

18 Since filing this case, FaceTec's counsel has been advised by Jumio's counsel that, even
19 though Jumio Showcase has a somewhat different user interface, it still uses iProov liveness
20 detection technology--not any new liveness detection technology proprietary to Jumio. Jumio's
21 counsel has advised that, while Jumio has indeed introduced its own proprietary liveness detection
22 technology, that technology was not introduced until after FaceTec's investigation underlying this
23 lawsuit, and is indeed still being rolled out. Having filed the complaint in this case on June 14,
24 FaceTec's counsel had not found and was not aware of such new Jumio technology as of the filing
25 of the complaint. In fact, we still have not located it in use, and Jumio's counsel has refused to
26 provide any details about it. However, they have indicated that it uses a different methodology
27 than the inventions described and claimed in the asserted FaceTec patents. They have also
28 indicated that Jumio is phasing out its use of iProov liveness detection technology.

1 In addition, iProov has recently moved to intervene in this case, indicating that iProov
2 technology is at issue here and that "iProov is better situated than Jumio to make
3 [noninfringement] arguments as Jumio embeds the iProov technology into its own applications."
4 iProov Motion to Intervene, Dkt. No. 36 at 2:8-10, 10:22-24.

5 Given this new information and new developments, it now appears to FaceTec that the
6 present lawsuit, while meritorious, adds little to the patent litigation against iProov that is already
7 well underway in the District of Nevada, which involves the same technology and two of the same
8 asserted FaceTec patents. It now appears likely that the current litigation will largely be an
9 unnecessary and wasteful duplication of that ongoing Nevada litigation. FaceTec therefore
10 requests voluntary dismissal of its claims in this case to avoid the potential for unnecessarily
11 expending party resources, to preserve scarce judicial resources, and to prevent the possibility of
12 contradictory rulings and judicial findings between this litigation and the District Court of Nevada
13 litigation.

14 Importantly, this litigation is at an early stage. Neither party has served discovery or
15 infringement or invalidity contentions, and no depositions have been noticed or taken place.
16 Because dismissal would thus result in no "plain legal prejudice" to Jumio, the Court should grant
17 FaceTec's request and dismiss its claims in this lawsuit without prejudice.

18 **II. Discussion**

19 FaceTec hereby requests pursuant to Fed. R. Civ. P. 41(a)(2) that the Court exercise its
20 discretion and enter an order dismissing FaceTec's patent claims in this matter without prejudice,
21 with the parties to bear their own attorneys' fees and costs.

22 In the Ninth Circuit, "[a] district court should grant a motion for voluntary dismissal under
23 Rule 41(a)(2) unless a defendant can show that it will suffer some plain legal prejudice as a
24 result." *Pasoon v. Equifax Info. Servs. LLC*, No. 24-cv-00072-AMO, 2024 U.S. Dist. LEXIS
25 70338, at *2 (N.D. Cal. Apr. 17, 2024) (quoting *Smith v. Lenches*, 263 F.3d 972, 975 (9th Cir.
26 2001); *Kamal v. Eden Creamery, LLC*, 88 F.4th 1268, 1279 (9th Cir. 2023) ("Generally, Rule
27 41(a)(2) grants a district court discretion to dismiss a case with or without prejudice."); *Hamilton*
28 *v. Firestone Tire & Rubber Co.*, 679 F.2d 143, 145 (9th Cir. 1982) (holding that the decision to

1 grant a voluntary dismissal under Rule 41(a)(2) “is addressed to the sound discretion of the
2 District Court.”).

3 Following the filing of FaceTec’s complaint in this action, counsel for FaceTec and Jumio
4 have met and conferred repeatedly regarding the substance of FaceTec’s patent infringement
5 allegations. During these discussions, counsel for Jumio has represented that all of the liveness
6 detection technology that FaceTec had analyzed before filing this complaint was provided to
7 Jumio by iProov and does not include any separate liveness detection technology from Jumio.
8 This includes even the Jumio-branded liveness detection technology that is used in the “Jumio
9 Showcase” app, which was identified in FaceTec’s complaint.

10 Counsel for FaceTec and iProov have also met and conferred regarding iProov’s request to
11 intervene in this litigation. During those discussions, counsel for iProov has made generally
12 similar representations (some of which were repeated in iProov’s intervention papers), suggesting
13 that iProov is the source of all the liveness detection technology that has been the basis for
14 FaceTec’s Complaint against Jumio. *See, e.g.*, iProov Motion to Intervene, Dkt. No. 36 at 2:8-10
15 (“But at bottom, FaceTec’s allegations of patent infringement clearly accuse iProov and its
16 technology of infringement.”); *Id* at 10:22-24 (“Indeed, iProov is better situated than Jumio to
17 make such arguments as Jumio embeds the iProov technology into its own applications.”) As
18 such, this litigation appears to be largely duplicative of the District Court of Nevada patent
19 litigation between FaceTec and iProov, which (1) has been ongoing for nearly 3 years and is now
20 at a more advanced stage, and (2) involves the same technology and several of the same FaceTec
21 patents that have been asserted here. *See Case No. 2:21-cv-02252-ART-BNW*. This concern
22 becomes particularly important given iProov’s request to intervene in this case.

23 In addition to the above, Jumio has represented that it is in the process of transitioning
24 Jumio’s customers away from technology sourced from iProov to a different liveness detection
25 technology. While FaceTec has yet to see the relevant details of this yet-to-be introduced
26 technology, Jumio has indicated that this technology is non-infringing because it uses a
27 substantially different liveness detection methodology than the inventions described and claimed
28 in the asserted FaceTec patents.

1 Based on these representations from both Jumio and iProov, this case appears to be both
2 duplicative of and unnecessary in light of the ongoing litigation between FaceTec and iProov.
3 FaceTec thus seeks voluntary dismissal of its affirmative patent claims to avoid unnecessarily
4 expending party resources, to preserve scarce judicial resources, and to eliminate the possibility of
5 contradictory rulings and judicial findings between this litigation and the District Court of Nevada
6 litigation.

7 Jumio will also suffer no legal prejudice as a result of this voluntary dismissal without
8 prejudice. This case is still at an early stage. No discovery requests have been served by either
9 party, neither party has served infringement or invalidity contentions, and no depositions have
10 been noticed or taken. Jumio will lose no defenses nor suffer any other legal or factual prejudice
11 as result of the dismissal. The Court should thus order dismissal without prejudice of FaceTec's
12 claims for patent infringement. *See Kamal*, 88 F.4th at 1279-80 (holding that a "District Court
13 should grant a motion for voluntary dismissal under Rule 41(a)(2) unless a defendant can show
14 that it will suffer some plain legal prejudice as a result") (quoting *WPP Lux. Gamma Three Sarl v.*
15 *Spot Runner, Inc.*, 655 F.3d 1039, 1058-59 n.6 (9th Cir. 2011)); *Westlands Water Dist. v. United*
16 *States*, 100 F.3d 94, 97 (9th Cir. 1996) ("Legal prejudice" is a term of art: it means "prejudice to
17 some legal interest, some legal claim, some legal argument."))

18 Importantly, the Ninth Circuit has made clear that "[u]ncertainty because a dispute remains
19 unresolved is not legal prejudice," and "the threat of future litigation which causes uncertainty is
20 insufficient to establish plain legal prejudice." *Westlands Water Dist.*, 100 F.3d at 96, 97.
21 FaceTec has been involved for almost three years in patent litigation in the District of Nevada
22 involving two of the same patents at issue in this litigation, but Jumio is not a party to that case.
23 iProov is the sole defendant in the District of Nevada. And even if the circumstances were
24 otherwise, "the mere inconvenience of defending another lawsuit does not constitute plain legal
25 prejudice." *Hamilton*, 679 F.2d at 145. Indeed, while Jumio will not have to defend the case in
26 Nevada, "plain legal prejudice does not result merely because the defendant will be
27 inconvenienced by having to defend in another forum or where a plaintiff would gain a tactical
28 advantage by that dismissal," *see Smith*, 263 F.3d at 975, 976, even that risk does not exist here.

Jumio’s declaratory-judgment counterclaims provide no reason to deny FaceTec’s request for dismissal. Even if Jumio chooses to continue pursuing those counterclaims after this voluntary dismissal, they would be subject to independent jurisdiction based on the Declaratory Judgment Act. The Court can dismiss FaceTec’s claims even over Jumio’s objection based on the language of Rule 41(a)(2) allowing such dismissal if a defendant’s counterclaims “can remain pending for independent adjudication.” FED. R. CIV. P. 41(a)(2).

III. Conclusion

For at the reasons above, FaceTec requests that the Court enter an order dismissing all of FaceTec’s claims in this action without prejudice. A proposed order is filed concurrently herewith. To the extent that the Court believes that any additional or different terms should be included in the order, or that this request raises any issues not addressed above, FaceTec requests an opportunity to be heard.

Dated: October 10, 2024

ONE LLP

By: /s/ Taylor C. Foss

Taylor C. Foss
Nathaniel L. Dilger
Peter R. Afrasiabi
William J. O’Brien

*Attorneys for Plaintiff and Counter-Defendant,
FaceTec, Inc.*

1 **CERTIFICATE OF SERVICE**

2 I hereby certify that on October 10, 2024, I electronically filed the foregoing document
3 with the Clerk of the Court using the CM/ECF system, which will send notification of such filing
4 to all counsel of record for the parties.

5 By: /s/ Taylor C. Foss

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